

### **REMARKS**

Applicant appreciates the notification of allowable subject matter, i.e. that claims 3, 5, 6, 40-42 and 83-85 would be allowable if rewritten in independent form.

Claims 1-6, 39-42, 44, 45, 82-89 and 123 have been cancelled without prejudice, and claims 124-173 have been added. No new matter has been added by virtue of the new claims. For instance, support for the amendments appears in the original claims of the application.

By amendments made herein, all the pending claims are method claims. The independent claims pending herein are claims 124, 125, 126, 127, 128 and 163. Independent claim 124 recites subject matter of former claim 3, which was indicated to be allowable. Independent claim 125 recites subject matter of former claim 5, which was indicated to be allowable. Independent claim 126 recites subject matter of former claim 6, which was indicated to be allowable. Independent claim 128 recites subject matter of former claim 40, which was indicated to be allowable. Independent claim 163 recites subject matter of former claim 83, which was indicated to be allowable.

Independent claim 127 calls for a method of preparing a photoresist composition that includes providing a polymer by a polymerization reaction that comprises adding a compound comprising a lactone moiety over the substantial course of the polymerization reaction to a reaction mixture.

A Supplemental Information Disclosure Statement is being submitted under separate cover.

Claims 1, 2, 4, 39, 44, 45, 82, 86-89 and 123 were rejected under 35 U.S.C. 102 over Hosaka et al. (U.S. Patent 4,384,037).

Claim 88 was rejected under 35 U.S.C. 102 over Hirayama et al. (U.S. Patent 6,028,123).

For the sake of brevity, the two rejections are addressed in combination. The rejections are traversed.

While Applicants fully disagree with the rejections, it is also believed the rejections are moot. As discussed above, independent claims 124, 125, 126, 127 and 163 recite subject matter indicated to be allowable over the cited documents. Independent claim 128 calls for adding a lactone to provide a polymer comprising units that comprise a lactone group, which is not disclosed in the cited documents.

In view thereof, reconsideration and withdrawal of the rejections are requested.

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



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